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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/143,343	08/28/1998	MARK A. BOYS	P644	3403
24739	7590	08/26/2004	EXAMINER	
CENTRAL COAST PATENT AGENCY PO BOX 187 AROMAS, CA 95004			TRAN, THAI Q	
			ART UNIT	PAPER NUMBER
			2616	25

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/143,343	BOYS, MARK A.
	<b>Examiner</b>	<b>Art Unit</b>
	Thai Tran	2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 09 June 2004.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-4, 17-19, 21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-4, 17-19, 21 and 22 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____.   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

**DETAILED ACTION*****Response to Arguments***

1. Applicant's arguments filed June 09, 2004 have been fully considered but they are not persuasive.

In re pages 5-9, applicant argues that Tognazzini therefore fails to disclose applicant's specific claim limitation of identifying the specific media portion by inserting the first and second flags into the media portion at any point in the continuous loop recording and in real-time during the media presentation as recited by claims 1 and 18.

In response, the examiner respectfully disagrees. Tognazzini discloses in col. 6, lines 8-10 that "When, **during performance of a piece of music on the radio**, one decides to record the music from the beginning, **record button 430** of Fig. 4 is pushed (530-thread C)" and in col. 8, lines 27-61 **that the start-of-program pointer and the stop pointer can be arbitrary set by using the record button and stop button**. It is clear from the above passages, that the start-of-program pointer and the stop pointer can be arbitrary set by using the record button and stop button during performance of a piece of broadcast program. Thus, Tognazzini does indeed discloses the claimed limitation of identifying the specific media portion by inserting the first and second flags into the media portion at any point in the continuous loop recording and in real-time during the media presentation as recited by claims 1 and 18.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 18-19 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Tognazzini ('147 B1) as set forth in paragraph #4 of the last Office Action.

Regarding claim 18, Tognazzini discloses a method for setting and initiating selective playback or permanent storage of media from a user-interface on a recording device coupled with a streaming audio or audio-visual media presentation device (Fig. 3) comprising steps of:

(a) initiating sequential continuous-loop recording of a specific time period of the presented media (col. 5, lines 41-49);

(b) identifying from the media presentation a specific media portion within the specific time period of the continuous-loop recording by inserting into the continuous-loop recording at any point and in real time during the media presentation, a first flag marking the beginning of, and a second flag marking the end of the identified media portion (col. 8, lines 27-61);

(c) activating a flag-set indicia from a user interface on the recording device (col. 8, lines 27-39);

(d) activating a recover indicia from the user interface of step (c), the recover operation for retrieving the flagged media (col. 8, lines 27-39); and

(e) initiating playback or media store of the flagged portion of media (col. 8, lines 27-39).

Regarding claim 19, Tognazzini discloses the claimed wherein the step (a), the recording is digital (col. 4, lines 48-53 and col. 8, lines 20-26).

Regarding claim 22, Tognazzini discloses the claimed wherein in step (d) the indicia is a memory button that searches for the set flags automatically (col. 8, lines 27-39).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tognazzini ('147 B1) as set forth in paragraph #6 of the last Office Action.

Regarding claim 1, as discussed above with respect to claim 18, Tognazzini discloses all the features of the claimed recording device (Fig. 3) coupled with a conventional streaming audio or audio-visual media representation device having

an input port (300 of Fig. 3, col. 4, lines 48-50) for accepting media from the media presentation device;

at least one recording mechanism (310 and 320 of Fig. 3, col. 4, lines 53-58 and col. 5, lines 41-49) associated with at least one data store facility having a memory with capacity for recording a specific time duration of a media presentation;

a user interface (330 and 340 of Fig. 3, col. 4, lines 63-67 and col. 8, lines 27-61) for controlling the function of record and for enabling functions of media transfer, store, and playback of recorded media; and

a user input (col. 8, lines 27-61) on the user interface for inserting into the recorded media at any point and in real time during the media presentation, a first flag marking the beginning of, and a second flag marking the end of the identified media portion, the flags searchable and usable as indicia for beginning a playback session of recorded media at a desired point in the recording sequence with the playback ending at a desired point in the recording sequence or for selecting a media portion of the recorded media for permanent storage;

wherein the recording mechanism is adapted to make a sequential, continuous-loop recording of the media presentation, such that when the memory capacity is filled, the device continues to record, overwriting the oldest recorded information, providing at any point in time a stored copy of the specific time duration of the recorded media immediately preceding the point in time (col. 5, lines 41-49). However, Tognazzini does not specifically disclose an output port

for enabling throughput of the media to a speaker system and optional visual display apparatus associated with the media presentation device.

The capability of using speaker system in the television receiver for audibly outputting the audio signal reproducing from the video cassette recorder is old and well known in the art and therefore Official Notice is taken.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well known television receiver having speaker system into Tognazzini's system in order to visually and audibly view the television signal reproduced from the recording medium 320 of Tognazzini .

Regarding claim 2, Tognazzini discloses the claimed wherein the recording device of claim 1 is coupled to one of an RF radio or a television (col. 4, lines 3-21).

Regarding claim 3, Tognazzini discloses an analog to digital converter and wherein the at least one data store is a write able digital memory accepting data writes comprising digitally recorded media (col. 4, lines 48-53).

Regarding claim 4, Tognazzini discloses wherein the flag-set denotes one of a complete song, or a block of completed songs (col. 5, line 66 to col. 6, line 7).

Regarding claim 17, Tognazzini discloses the claimed wherein coupling results in internalizing the device into the circuitry of the media presentation device (Fig. 3).

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6. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tognazzini ('147 B1) in view of Ichinose ('569) as set forth in paragraph #7 of the last Office Action.

Tognazzini discloses all the features of the instant invention as discussed in claim 18 above except for providing wherein in step (d) the indicia is a jogging wheel manually operated to search the flag-sets.

Ichinose teaches a video editing viewer having a jogging wheel (6 of Fig. 1, col. 2, lines 14-39) for selecting an editing point.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the rotary knob 6 of Ichinose into Tognazzini's system in order to facilitate the processing of searching the beginning of each program.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

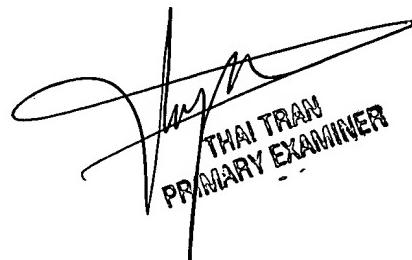
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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thai Tran whose telephone number is (703) 305-4725. The examiner can normally be reached on Mon. to Friday, 8:00 AM to 5:30 PM.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TTQ



A handwritten signature in black ink, appearing to read "Thi Tran". Below the signature, the text "THAI TRAN" is printed vertically, followed by "PRIMARY EXAMINER" in a slightly smaller font.